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MEMORANDUM

Date: January 21, 2010
To: *[Signature]*
Technology Center Directors
Patent Examining Corps
From: Robert W. Bahr
Acting Associate Commissioner
for Patent Examination Policy
Subject: Changes to Restriction Form Paragraphs

The purpose of this memorandum is to clarify Office policy with respect to communicating election of species requirements to applicants and with respect to establishing burden in the context of a restriction requirement. The guidance and form paragraphs set forth herein supersede the April 25, 2007 memorandum regarding changes to restriction form paragraphs, form paragraphs 8.01, 8.02, and 8.21 currently in the Office Action Correspondence Subsystem (OACS), and form paragraphs 8.01, 8.02, 8.21.01-8.21.03, and 8.22 currently in MPLP Chapter 800 (8th Ed., rev. 7, July 2008).

Form paragraphs 8.01 and 8.02 concerning election of species have caused confusion for some patent examiners and applicants with regard to (1) whether the applicant must always elect a single species, (2) why the species from which applicant is required to elect are independent or distinct, and (3) why there would be a burden on the examiner if an election of species were not required.

First, it is never appropriate to require an election between species (or inventions) that are not patentably distinct. In setting forth the species from which an applicant is required to elect, the examiner should group together species that are not patentably distinct from each other. Form paragraphs 8.01 and 8.02 have been revised by adding references to "grouping(s) of patentably indistinct species" so as to permit examiners to require election of either a single species or a single grouping of patentably indistinct species. As explained in the examiner notes, where the election requirement identifies a grouping of patentably indistinct species, applicant should not be required to elect a specific species within that grouping.

Second, form paragraphs 8.01 and 8.02 as set forth in the April 25, 2007 memo and in OACS specify that the species are independent or distinct "because claims to the different species recite the mutually exclusive characteristics of such species." However, this exemplary language is inadequate in certain cases, and it may be necessary to set forth additional details and/or different reasons to support the requirement for election. Therefore, form paragraphs 8.01 and 8.02 have been revised to permit the

examiner to set forth an explanation as to why the species or grouping(s) of species are independent or distinct.

Third, with regard to the burden requirement, form paragraphs 8.01 and 8.02 as set forth in the April 25, 2007 memo and in OACS presume there is a burden to search and/or examine patentably distinct species “due to their mutually exclusive characteristics,” and assert that at least one of several possible reasons apply. Similarly, form paragraph 8.21, which concludes all restriction requirements other than those setting forth only an election of species, explains that there would be a serious search and/or examination burden if restriction were not required because one or more of reasons listed therein apply. None of these form paragraphs currently provide for the examiner to identify the specific reason(s) why there would be a search and/or examination burden if restriction were not required in the application under examination.

As noted in MPEP §§ 803 and 808.02, if the examination and search of all the claims in an application can be made without serious burden, restriction should not be required, even though they are drawn to independent or distinct inventions, including species. To help ensure that all restriction requirements, including election of species requirements, set forth the requisite burden, and to give the applicant notice of why there is a burden, form paragraphs 8.01, 8.02, and 8.21 have been revised to provide for the examiner to specify at least one applicable reason. Possible applicable reasons are listed in the examiner notes to the form paragraphs, and are consistent with MPEP § 808.02.

Note that form paragraphs 8.01 and 8.02 as set forth in MPEP Chapter 800 do not include an explanation regarding burden, however the restriction requirement is to be concluded with one of form paragraphs 8.21.01-8.21.03 as set forth in that chapter. Revised form paragraphs 8.01 and 8.02 as set forth below include the burden explanation; furthermore, revised form paragraph 8.21 consolidates and replaces form paragraphs 8.21.01-8.21.03 and 8.22 as set forth in MPEP Chapter 800.

The following form paragraphs will be available as custom form paragraphs until the release of the next OACS update.

Revised form paragraphs 8.01, 8.02 and 8.21

¶ 8.01 Requiring an Election of Species; Species Claim(s) Present

This application contains claims directed to the following patentably distinct species [1]. The species are independent or distinct because [2]. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, [3] generic

There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply:

[4]. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or a grouping of patentably indistinct species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species or grouping of patentably indistinct species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species or grouping of patentably indistinct species.

Should applicant traverse on the ground that the species, or groupings of patentably indistinct species from which election is required, are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or

clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Examiner Note:

1. In bracket 1, identify the species and/or grouping(s) of patentably indistinct species from which an election is to be made. The species may be identified as the species of figures 1, 2, and 3, for example, or the species of examples I, II, and III, respectively. Where the election requirement identifies a grouping of patentably indistinct species, applicant should not be required to elect a specific species within that grouping.
2. In bracket 2 insert the reason(s) why the species or grouping(s) of species are independent or distinct. See MPEP § 806.04(b), § 806.04(f) and § 806.04(h). For example, insert --the claims to the different species recite the mutually exclusive characteristics of such species-- and provide a description of the mutually exclusive characteristics of each species or grouping of species.
3. In bracket 3 insert the appropriate generic claim information.
4. In bracket 4 insert the applicable reason(s) why there is a search and/or examination burden:
 - the species or groupings of patentably indistinct species have acquired a separate status in the art in view of their different classification
 - the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter
 - the species or groupings of patentably indistinct species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search strategies or search queries).
5. This form paragraph does not need to be followed by form paragraph 8.21.

¶ 8.02 Requiring an Election of Species; No Species Claim Present

Claims [1] is/are generic to the following disclosed patentably distinct species: [2]. The species are independent or distinct because [3]. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply:

[4].

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or a grouping of patentably indistinct species to be examined even though the requirement may be reversed (37 CFR 1.113) and (ii) identification of the claims encompassing the elected species or grouping of patentably indistinct species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traverse must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species or grouping of patentably indistinct species.

Should applicant traverse on the ground that the species, or groupings of patentably indistinct species from which election is required, are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Examiner Note:

1. This form paragraph should be used for the election of species requirement described in MPEP § 803.02 (Markush group) and MPEP § 808.01(a) where only generic claims are presented.
2. In bracket 1, insert the claim number(s).
3. In bracket 2, clearly identify the species and/or grouping(s) of patentably indistinct species from which an election is to be made. The species may be identified as the species of figures 1, 2, and 3, for example, or the species of examples I, II, and III, respectively. Where the election requirement identifies a grouping of patentably indistinct species, applicant should not be required to elect a specific species within that grouping.
4. In bracket 3 insert the reason(s) why the species or groupings of species as disclosed are independent or distinct. See MPEP § 806.04(b), § 806.04(f) and § 806.04(h). For example, insert --as disclosed the different species have mutually exclusive characteristics for each identified species-- and provide a description of the mutually exclusive characteristics of each species or grouping of species.
5. In bracket 4 insert the applicable reason(s) why there is a search and/or examination burden:

--the species or groupings of patentably indistinct species have acquired a separate status in the art in view of their different classification

--the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter

--the species or groupings of patentably indistinct species require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).

6. This form paragraph does not need to be followed by form paragraph 8.21.

¶ 8.21 To Establish Burden AND Requirement for Election and Means for Traversal for all Restrictions, other than an Election of Species

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply:

[1]

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Examiner Note:

1. THIS FORM PARAGRAPH MUST BE ADDED TO ALL RESTRICTION REQUIREMENTS other than those containing **only election of species**, with or without an action on the merits. This form paragraph only needs to be used once, after all restriction requirements are set out.

2. In bracket 1 insert the applicable reason(s) why there is a search and/or examination burden:

--the inventions have acquired a separate status in the art in view of their different classification

--the inventions have acquired a separate status in the art due to their recognized divergent subject matter

--the inventions require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).